



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/786,718

02/24/2004

Mark Banister

MEDIPACS 04.03

2762

27667 7590 09/16/2008  
HAYES SOLOWAY P.C.  
3450 E. SUNRISE DRIVE, SUITE 140  
TUCSON, AZ 85718

EXAMINER

FREAY, CHARLES GRANT

ART UNIT

PAPER NUMBER

3746

MAIL DATE

DELIVERY MODE

09/16/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/786,718	<b>Applicant(s)</b> BANISTER, MARK	
	<b>Examiner</b> Charles G. Freay	<b>Art Unit</b> 3746	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) 8-15, 17 and 27-57 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 15, 17 and 19-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

This office action is in response to the Amendment of June 13, 2008. In making the below rejections the examiner has considered and addressed each of the applicant's arguments.

### ***Information Disclosure Statement***

With regards to the Information Disclosure Statement of October 3, 2005 the PCT Written Opinion has been considered and the art cited therein is already of record and cited on other PTO-1449's.

### ***Drawings***

The drawings were received on June 13, 2008. These drawings are approved.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Culp (USPN 5,192,197) as set forth in the previous office action.

Claims 1, 3, 4 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by da Costa (USPN 6,004,115) as set forth in the previous office action.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Culp or da Costa as set forth in the previous office action.

Claims 19-21 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over either of Culp or da Costa in view of Chinn et al as set forth in the previous office action.

***Response to Arguments***

Applicant's arguments filed June 13, 2008 have been fully considered but they are not persuasive. The applicant argues against Culp because the “dimorphs” do not change dimensions but instead move in position relative to one another. Furthermore, the applicant argues against Culp because each dimorph is composed of two body sections, rather than being an individual actuator. The applicant argues against da Costa because the claim requires the actuators to be the “same or similarly sized” and the applicant argues that da Costa is not. The applicant argues against the rejections under 35 USC 103 because of the deficiencies set forth above with regards to Culp and da Costa.

With regards to the arguments against Culp the examiner disagrees.

Firstly, the dimensions of Culp do change as clearly shown in Figs. 1 and 2 and as described at col. 3 lines 49-63. As set forth in the above passage the electrodes 6a and 6b displace or stroke relative to one another by a distance 12. From Fig. 2 it can clearly be seen that the total “vertical” distance from the lower left-hand corner of the actuator to the upper right-hand corner of the actuator has increased by a distance 12.

Furthermore the angular relationships between the adjacent sides of the actuator have changed during shear. While the passage cited by the applicant states that the height remains constant. This passage when read in view of the figures makes clear that it is the distance in a plane in the direction of polarity of the actuator that remains constant and not the total height of the actuator.

With regards to the argument that the element shown in Figs. 1 and 2 is not an individual actuator the examiner disagrees. The claims merely set forth an individual actuator and set forth no further structure of the actuator. The examiner agrees that the actuator of Culp includes multiple parts but the claim does not limit the actuator to any particular structure or number of parts. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that an individual actuator cannot have multiple parts) are not recited in the rejected claim(s). Although the claims are

Art Unit: 3746

interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With regards to the applicant's arguments with respect to *da Costa* the examiner disagrees. The claim requires that there are a plural of same *or similarly sized* actuators in the chamber. This limitations does not limit the invention to having every actuator in the chamber being the same size. As shown in Figs. 1a-1c the first set of three actuators from the left are of similar size and also the second set of three actuators from left are of similar size. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., all of the actuators being same sized) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The above arguments also address the applicant's arguments against the rejections under 35 USC 103.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 3746

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles G. Freay whose telephone number is 571-272-4827. The examiner can normally be reached on Monday through Friday 8:30 A.M. to 5:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Devon Kramer can be reached on 571-272-7118. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3746

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charles G Freay/  
Primary Examiner, Art Unit 3746

CGF  
September 10, 2008